

R E M A R K S

This Amendment and Response is responsive to the non-final Office Action mailed on April 20, 2007 (hereinafter the “Office Action”). The status of the claims is as follows:

- Claims **31-45** have been withdrawn from consideration;
- Claims **48-71** were canceled previously;
- Claims **30, 46 and 47** have been amended; and
- Claims **30-47** are pending in the present application.

Of the claims currently pending in the application, claims **30, 46 and 47** are the only independent claims.

The 35 U.S.C. §112, First Paragraph Rejection

Claims **30, 46 and 47** were rejected because: “the instant application does not reasonably provide enablement for a fourth party (party different from the buyer) providing payment.”(Office Action, page 4). The Examiner submits that, since the purchasing system is responsible for the ultimate payment to the retailer, for purposes of prosecution the phrase “a party different from the buyer” has been interpreted as being the purchasing system.

Claim **30** has been amended to replace the phrases that recite “a party different from the buyer” as follows:

*receiving a payment **from a subsidy provider** in exchange for
providing the product to the buyer,
wherein the payment is based on a first price of the product agreed
upon between the retailer and **the subsidy provider** and not on a second
price of the product that the buyer agreed to pay.*

Claims **46 and 47** have been similarly amended. Support for these changes can be found, for example, in published application US 2004/0243478 at paragraphs [0525] and [0526] and in Fig. 57A. In particular, Fig. 57A depicts multiple parties including a subsidy provider in addition to the purchasing system, retailer, and the buyer. No new matter has been added.

Applicants respectfully submit that claims **30, 46 and 47** now clearly recite that a subsidy provider provides a payment, and that the payment is based on a first price of the product agreed upon between a retailer and the subsidy provider. In addition, we submit that the specification provides for enablement of a subsidy provider to provide a payment. Accordingly, claims **30, 46 and 47** each enables one skilled in the art to practice the invention commensurate with the scope of these claims.

In view of the above amendments and remarks, we respectfully request withdrawal of the 35 U.S.C. §112, first paragraph rejection of claims **30, 46 and 47**.

The 35 U.S.C. §112, Second Paragraph Rejection

Claims **46 and 47** were rejected for providing insufficient antecedent basis for the first occurrences of the phrase “the buyer” and the phrase “the purchasing system”. Consequently, claim **46** has been amended to replace the word “the” with “a” in lines 5, 6 and 7, and claim **47** has been amended to replace the word “the” with “a” in lines 2, 3 and 4. No new matter has been added.

In view of the above amendments and remarks, we respectfully request withdrawal of the 35 U.S.C. §112, Second Paragraph rejections of claims **46 and 47**.

The Double Patenting Rejection

Claims **30, 46 and 47** stand rejected on the ground of nonstatutory double patenting over specified claims of U.S. Patent No. 6,754,636. We respectfully traverse.

Any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. §103 obviousness determination. MPEP 804(II)(B)(1). Thus, the factual inquiries set forth in Graham v. John Deere that are applied for establishing a background for determining obviousness under 35 U.S.C. §103 are employed when making an obvious-type double patenting analysis. MPEP 804(II)(B)(1). When considering whether a claim of an application is an obvious variation of a claim of a patent, the disclosure of the patent may not be used as prior art. MPEP 804(II)(B)(1).

As explained above, claims **30, 46 and 47** have been amended. In view of the changes, Applicants respectfully submit that the Examiner’s finding of similar subject

matter cannot support a determination of double patenting. In particular, claims 1, 15 and 16 of the '636 patent each require "arranging for the buyer to take possession of the product at a retailer" and "transmitting to the retailer verification information... wherein the buyer provides a payment... to the purchasing system". Claims 17, 22 and 23 of the '636 patent each require "establishing, between a customer and the purchasing system, a second price... not dependent on the first price" and "collecting a payment of a second price from the customer". None of the pending claims **30, 46 and 47** requires such limitations. Furthermore, each of claims **30, 46 and 47** recites specific features that have not been addressed by the Examiner, and each now recites receiving payment from a subsidy provider in exchange for providing the product to the buyer. The issued claims do not expressly require such a feature.

We respectfully submit that no claims are identical in scope, and that any differences must be identified and addressed by the Examiner in accordance with a proper obviousness analysis. Although the pending claims and the issued claims may overlap in scope with respect to some types of embodiments, that consideration alone is not enough to reject the pending claims for double patenting. In addition, no motivation to modify or combine teachings has been provided in support of the double patenting rejections. Lacking a motivation to modify the scope of the issued claims, there is no *prima facie* case of obviousness. In re Rouffet, 149 F.3d 1350, 1358 (Fed. Cir. 1998).

In view of the above remarks, we respectfully request reconsideration and withdrawal of the obviousness double patenting rejection of claims **30, 46 and 47**.

The 35 U.S.C. §103(a) Rejections

Claims **30, 46 and 47** were rejected for being unpatentable over the Sendwine.com reference (hereinafter "Sendwine") in view of The Record reference (hereinafter "The Record"). We traverse.

Sendwine discloses a business model involving an Internet seller of wines (Sendwine.com), a buyer, and a retailer (a retail wine shop). In order to comply with various state regulations and local tax issues, the seller (Sendwine.com) does not ship wine directly to the buyer. Instead, Sendwine.com relays the sale to a wine shop (that has contracted with Sendwine.com) that is located near the buyer, and that wine shop delivers

the wine to the buyer. The Record discloses a system wherein the buyer (consumer) picks up his Internet order at a retail outlet (wine shop), which ensures that alcoholic beverages are not provided to underage consumers.

In contrast, claims **30, 46 and 47** recite a method, device, and retailer system apparatus for providing a product to a buyer who purchased the product through a purchasing system. The process includes:

receiving from the buyer redemption information;
receiving from the purchasing system verification information
enabling the authorization of the buyer to take possession of the product;
providing the product to the buyer; and
receiving a payment from a subsidy provider in exchange for
providing the product to the buyer,
wherein the payment is based on a first price of the product agreed
upon between a retailer and the subsidy provider and not on a second
price of the product that the buyer agreed to pay.

Applicants respectfully assert that the pending claims are patentably distinct from Sendwine and The Record, as neither of these references, alone nor in combination, teaches or suggests the retailer receiving a payment from a subsidy provider in exchange for providing the product to the buyer. In fact, there is no mention of a subsidy provider at all in either reference. Furthermore, the pending claims require that the payment be based on a first price of the product agreed upon between a retailer and the subsidy provider, and not on a second price of the product that the buyer agreed to pay. Such a feature is not even suggested by the cited references.

In view of the above amendments and remarks, we respectfully request withdrawal of the 35 U.S.C. §103 rejections of claims **30, 46 and 47**.

Withdrawn Dependent Claims 31-45

Should independent claim **30** be found to be allowable, Applicants respectfully request that the Examiner reconsider the restriction of dependent claims **31-45**. Since

under such circumstances claim **30** would be an allowable generic claim, we respectfully submit that rejoinder and the allowance of claims **31-45** would be in order.

Authorization to Charge Appropriate Fees

Applicants herein petition for a one-month extension of time to respond, and authorize the Commissioner to charge Deposit Account No. 50-0271 for the surcharge fee. We do not believe that any other fees are due, but if a fee should be necessary to continue prosecution of the present application, please also charge any such required fee to our Deposit Account No. 50-0271. In addition, please credit any overpayment to Deposit Account No. 50-0271.

CONCLUSION

Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

If the Examiner has any questions regarding this amendment or the present application, the Examiner is cordially requested to contact Stephan Filipek at telephone number (203) 461-7252 or via electronic mail at sfilipek@walkerdigital.com.

Respectfully submitted,

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Date

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